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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,271	10/23/2001	Frits Jacobus Fallaux	3833.6US	8381
24247	7590	10/07/2003	EXAMINER	
TRASK BRITT			NGUYEN, DAVE TRONG	
P.O. BOX 2550			ART UNIT	PAPER NUMBER
SALT LAKE CITY, UT 84110			1632	9
DATE MAILED: 10/07/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/038,271	FALLAUX ET AL.	
	Examiner	Art Unit	
	Dave T Nguyen	1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 July 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-6 and 30-39 is/are pending in the application.

4a) Of the above claim(s) 39 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-6 and 30-38 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 23 October 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. 08/793,170.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .

4) Interview Summary (PTO-413) Paper No(s) .

5) Notice of Informal Patent Application (PTO-152)

6) Other: .

Claims 1-6 have been amended, claims 30-39 have been added by the amendment filed July 15, 2003 (Paper No. 8).

Applicant's election with traverse of the Group I claims, claims 1-6, in Paper No. 8 is acknowledged. Newly added claim 39 is directed to an invention which is not claimed in the originally filed Group I claims. More specifically, claim 39 is directed to a product by process claim, wherein a product drawn to replication defective adenoviral particles free of RCA. However, such product is not limited by the process of making as being elected by application, and can be made by other known methods such as those employing helper adenoviruses that expressed a protein IX product. Thus, the invention as claimed in claim 39 is distinct from that of the Group I claim, and has been withdrawn by the examiner as a non-elected claimed invention.

Elected claims 1-6, 30-38 are pending for examination.

Claim 1 is objected because on line6 of claim 1, the phrase "transferring recombinant nucleic acid" lacks the article "a" between "transferring" and "recombinant".

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 30-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of US 5,994,128, claims 1-14 of US 6,306,652.

Although the conflicting claims are not identical, they are not patentably distinct from each other because: The examined claims encompass a method of employing adenovirus sequences expressing E1A and E1B but not protein IX for the making of RCA-free replication defective adenovirus carriers. Given that claims 1-20 of the '128 patent and claims 1-14 of the '652 patent are drawn to essentially the same concept of utilizing a system comprising a primary cell consisting essentially of adenovirus sequences expressing E1A and E1B but not protein IX for the making of RCA-free replication defective adenovirus carriers, the examined claims and the claims from either the patent are obvious variants of one another.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Dave Nguyen* whose telephone number is **(703) 305-2024**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Deborah Reynolds*, may be reached at **(703) 305-4051**.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is **(703) 305-7401**.

Any inquiry of a general nature or relating to the status of this application should be directed to the *Group receptionist* whose telephone number is **(703) 308-0196**.

Application/Control Number: 10/038,271
Art Unit: 1632

Page 4

Dave Nguyen
Primary Examiner
Art Unit: 1632



DAVE T. NGUYEN
PRIMARY EXAMINER